

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-119 are currently pending. Claim 61 has been amended by the present amendment. The changes to Claim 61 are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-119 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and Claims 1-119 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,202,092 to Takimoto (hereinafter “the ‘092 patent”) in view of U.S. Patent Application No. 5,509,074 to Choudhury et al. (hereinafter “the ‘074 patent”).

Applicants respectfully submit that the rejections of Claims 61-82 under 35 U.S.C. § 101 are rendered moot by the present amendment to Claim 61. Claim 61 has been amended to be directed to a “computer-readable storage medium having encoded therein a program for printing, the program causing a computer to execute the steps of” Accordingly, Applicants respectfully submit that Claims 61-82 satisfy the requirements of 35 U.S.C. § 101 since a computer-readable storage medium is statutory.

Applicants respectfully traverse the rejection of Claims 1-60 and 83-119 under 35 U.S.C. § 101. As stated in the Office Action, the basis for this rejection is that those claims “seek patent protection for an abstract idea of computer-executable instructions as evident by Claims 61-82.”¹ However, Applicants respectfully submit that that scope of Claims 61-82 is not relevant to whether Claims 1-60 and 83-119 are directed to statutory subject matter. For example, Applicants note that Claim 1 is directed to a printing system, including a printing apparatus, a terminal apparatus, a notification means, and a network. Moreover, Claim 19 is

¹ See pages 1 and 2 of the outstanding Office Action. Emphasis added.

directed to a printing apparatus including a central processing unit and notification means. Moreover, Claim 27 is directed to a terminal apparatus including a central processing unit, a query means, and presentation means. Thus, contrary to the assertion in the outstanding Office Action, Claims 1, 19, and 27 are not directed to “an abstract idea of computer executable instructions.” Rather, Applicants respectfully submit that the printing system, the printing apparatus, and the terminal apparatus recited in Claims 1, 19, and 27, respectively, are *per se* statutory. It is unclear to Applicants how Claim 1 can be rejected under 35 U.S.C. § 101 based on the contents of Claim 61. For example, if Applicant presented only Claim 1, and no other claims, would Claim 1 then be statutory? For the reasons stated above, Applicants respectfully traverse the rejection of Claims 1-60 and 83-119 as directed to non-statutory subject matter.

Claim 1 is directed to a printing system, comprising: (1) a printing apparatus; (2) a terminal apparatus for transmitting information including a request to execute a print job and for receiving information; (3) notification means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus prior to the transmission of the request to execute the print job to be printed by the printing apparatus, but after the registered user as established access to use of the printing apparatus; and (4) a network connecting the printing apparatus, the terminal apparatus, and the notification means so that information transmission and reception in the system is performed through an electrical signal via the network.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the ‘092 patent discloses everything in Claim 1 with the exception of “notifying a user prior to the transmission of the request to execute the print job to be printed by the printing apparatus,” and relies on the ‘747 application to remedy that deficiency.

The '092 patent is directed to a print system including a shared printer on a network in which the authority of each user to use the printer is set in a security database. After a print request, including the number of sheets to be printed, is sent to a security validating device, the '092 patent discloses that the security validating device decides whether authorization to use the printer is to be granted based on the restrictions on the user maintained in the database and the status of the user. Further, the '092 patent discloses that, if the printing is authorized, the printing is completed and the status of the user is updated in the security database. However, as admitted in the Office Action, the '092 patent fails to disclose means for notifying a user of the printing apparatus of information on authority of the registered user to use the printing apparatus prior to the transmission of the request to execute the print job to be printed by the printing apparatus, as recited in Claim 1.

The '074 patent is directed to a method of protecting electronically published materials including the step of receiving a request for documents from a user having a computer with a display device or a printer, wherein the request includes an identification of the user. Further, the '074 method includes the steps of authenticating the request with a copyright server, using the copyright server to direct a document server to act upon proper authentication of the request, using the document server to create a uniquely encoded, compressed, and encrypted document for each authenticated request, and forwarding the documents through the network to corresponding agents of each authenticated user. As shown in the flowchart of Figure 4, the '074 patent discloses that, in Step 232, the request for documents is received along with a unique user ID from a user computer via the network. In response, as shown in Steps 234-246, the system authenticates the request and the documents are ultimately forwarded to the user who requested the documents.

However, Applicants respectfully submit that the '074 patent fails to disclose notification means for notifying a registered user of the printing apparatus of information on

authority of the registered user to use the printing apparatus prior to the transmission of the request to execute the print job to be printed by the printing apparatus, as recited in Claim 1. Rather, the teachings of the '074 patent are similar to those of the '092 patent. A registered user is not notified of information on their authority to use the printing apparatus prior to the transmission of the request to execute the print job. Rather, the '074 patent discloses that the user receives the documents if there is authentication of the user. However, Claim 1 requires that the registered user be notified on authority of the registered user to use the printing apparatus prior to the transmission of the request to execute the print job to be printed by the printing apparatus. The '074 patent discloses that the request is sent along with a user ID and in response, the user receives or does not receive the print document. The user is not notified prior to the transmission of the request to execute the print job, as required by Claim 1. Rather, the '074 patent discloses that the request is sent first, and there is no notification, other than the user actually receiving the document.

Thus, no matter how the teachings of the '092 and '074 patents are combined, the combination does not teach or suggest notification means for notifying a registered user of the printing apparatus of information on authority of the registered user to use the printing apparatus prior to the transmission of the request to execute the print job to be printed by the printing apparatus, but after the registered user has established access to use of the printing apparatus, as recited in Claim 1. Accordingly, Applicants respectfully submit that the *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 2-18) should be withdrawn.

Claims 19, 27, 38, 61, 83, 101, and 109 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of

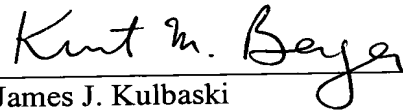
obviousness has not been established and the rejections of Claims 19, 27, 38, 61, 83, 101, and 109 (and all associated dependent claims) should be withdrawn.

Thus, it is respectfully submitted that independent Claims 1, 19, 27, 38, 61, 83, 101, and 109 (and all associated dependent claims) patentably define over any proper combination of the '092 and '074 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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